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APPLICATION NO. 09/010,400	FILING DATE 01/22/99	FIRST NAMED INVENTOR SHAH M	ATTORNEY DOCKET NO. 15517-000132
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EXAMINER ZANELLI, M

ART UNIT 3661	PAPER NUMBER 12
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DATE MAILED: 03/15/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

*PTB-326 copy
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M2
4/15/99*

Office Action Summary

Application No.

02/010,408

Applicant(s)

Shah et al.

Examiner

M. Zarelli

Group Art Unit

3661

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 8/13/98 & 2/8/99

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 21-53 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 21-53 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

1. This is responsive to the communication filed 2/8/99. The second preliminary amendment filed 8/13/98 was not matched with the file until after the Office action was mailed on 11/10/98 (remailed on 1/7/99). Therefor the previous Office action has been withdrawn and the preliminary amendment, as well as the instant amendment, have been entered. Claims 21-53 are pending.

2. Claims 43-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. As per claim 43, the claim is vague and unclear as to the reference to "a second selected segment of interest" since there is no recitation of a first selected segment of interest.

B. All claims depending from a rejected base claim are also rejected as containing the same deficiencies.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438,

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164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 21-53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over at least claims 6 and 19 of U.S. Patent No. 5,428,546. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims encompass the subject matter now being claimed. The patented claims include three databases containing mobile unit information, raster information, and vector information which is processed by a means for interrelating the information. The application claims represent a subset (subcombination) of the overall tracking system. The application claims are further provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over at least claims 1 and 13 of U.S. Patent No. 5,636,122 and at least claim 1 of U.S. Patent No.

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5,594,650. Both of these patents claim subject matter which encompasses the database system now being claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 43-45, and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Wortham (5,155,689).

A. Wortham discloses a fleet management system which tracks the location of a plurality of mobile units at a remote location (see Abs. and Fig. 1). The remote location or base station (10) includes a computer terminal which allows a dispatcher to monitor the location and status of hauling vehicles (24) using two-way wireless communication (22) (col. 8, lines 34+). The base station monitors the vehicles and pulls up information regarding the last reported location and status information and communicates with a particular vehicle to receive updated location and status information (col. 5, lines 15+).

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wortham (5,155,689) in view of Simms et al. (5,334,974; hereinafter Simms).

A. Wortham is applied as above. Wortham discloses one embodiment in which longitude and latitude data for the vehicle may be obtained by a LORAN-C receiver and the information communicated to the base station (see col. 3, lines 29-31). One of ordinary skill in the navigation arts would have found it obvious to provide the longitude and latitude data using alternative means.

B. For example, Simms monitors the location of a vehicle using LORAN-C or GPS and communicates the location information to a remote station (Fig. 1). Since it was known in the navigation arts that one could obtain longitude and latitude data for a mobile unit using either LORAN-C or GPS, one of ordinary skill in the art would have

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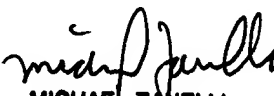
found it obvious to substitute a GPS receiver for the LORAN-C receiver of Wortham because both provide the necessary longitude and latitude data referred to by Wortham (see col. 7, lines 62+).

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael Zanelli** whose telephone number is (703) 305-9756 (M-Th, 6:30-5:00 PM).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

/mjz
March 10, 1999


MICHAEL ZANELLI
PRIMARY EXAMINER